

Communication to Record Substance of Interview
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Dated: December 23, 2010
Electronic Signature for Barbara A. Saltsman: / Barbara A. Saltsman /

Docket No.: 1258_3378US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Ulrich Wiesner et al.

Application No.: 10/536,569

Confirmation No.: 2178

Filed: May 2, 2006

Art Unit: 1639

For: FLUORESCENT SILICA-BASED
NANOPARTICLES

Examiner: C. M. Gross

COMMUNICATION TO RECORD SUBSTANCE OF INTERVIEW

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Remarks/Arguments begin on page 2 of this paper.

REMARKS

A telephone interview was conducted on September 30, 2010 with the following persons participating: Examiner Christopher M. Gross, Applicant Ulrich Wiesner, Applicant Hooisweng Ow, Applicant's attorney Anne Schneiderman, Applicant's representative Brian Ho, and licensee Hybrid Silica, Inc.'s representative Kenneth Wang. Procedural matters were discussed, specifically:

(1) Examiner Gross suggested that in the Applicants' response to the outstanding Final Office Action dated July 7, 2010, the rejection of claims 46 and 47 under 35 U.S.C. 112 be addressed, that evidence be submitted that overcomes the new matter rejection, and that claim 47 be amended to recite limitations that are supported by the specification of the present application (US 2006/0183246), which incorporates by reference non-provisional application U.S. Ser. No. 10/306,614 ("the '614 application," US 2004/0101822) filed Nov. 26, 2002; and

(2) Examiner Gross suggested that the Applicants submit additional evidence and arguments setting forth reasons for why the teachings of Battersby et al. ("Battersby," WO 00/32542), and in particular, Battersby's teaching of the use of the method of van Blaaderen et al. (1992, *Synthesis and Characterization of Colloidal Dispersions of Fluorescent, Monodisperse Silica Spheres* *Langmuir* 8: 2921-2931), are unsuitable for preparing the nanoparticles of claim 40 (and claims 45-53 depending therefrom), and thus, do not render the claimed nanoparticles obvious. The Examiner further suggested that evidence be submitted concerning the unstable silica cores (taught by Battersby) as unsuitable and/or formula 3.1 of Battersby not being applicable toward preparing silica cores with fluorescent dyes throughout the core.

The Applicants and their attorney agreed to submit an amendment and response, which is being filed concurrently herewith and which addresses items (1) and (2) above.

If there are any other fees due in connection with the filing of this response or accompanying papers, please charge our Deposit Account No. 50-0289, under Order No. 1258_3378US from which the undersigned is authorized to draw.

Respectfully submitted,

Date: December 23, 2010

/Anne M. Schneiderman 43095/ 43,095

Anne M. Schneiderman

Reg. No.

For: MARJAMA MULDOON BLASIAK & SULLIVAN LLP
250 South Clinton St. Suite 300
Syracuse, NY 13202
(315) 425-9000 phone
(315) 425-9114 fax
Customer No. 20874

AMS/bas